

REMARKS

Claims 1, 2, 5-9, 11-14, and 17-23 are pending. Claims 19-23, which are drawn to a non-elected invention, stand withdrawn from consideration. Claims 1, 2, 5-9, 11-14, 17, and 18 stand rejected. Claims 3, 4, 10, 15 and 16 are canceled without prejudice or disclaimer. Claims 1 and 13 are amended, in part to incorporate the subject matter of canceled claims 4 and 16. Support for the amendments can be found, *inter alia*, in paragraph [0026]¹ of the Specification and Figures 2-5. No new matter is added herein.

Applicant has thoroughly reviewed the Office action, including the Examiner's remarks and the references cited therein. Applicant submits that the following remarks are fully responsive to the Office action, and that all pending claims are patentable over the cited references.

Objection to the Specification

The Examiner objects to the specification for failing to provide proper antecedent basis for claim 10. Applicant submits that this objection is moot in light of the cancellation of claim 10.

Rejection Under 35 U.S.C. § 102

The Examiner rejects claims 1-3 and 12 under 35 U.S.C. § 102(e) as anticipated by United States patent application publication no. 2004/0215139 to Cohen ("Cohen"). To be anticipatory, a single prior art reference must explicitly or inherently teach each and every element of the claimed invention. MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987)). The rejection of claim 3 is moot in view of its cancellation. As to the remaining claims, Applicant respectfully submits that Cohen does not meet this standard.

Claim 1 has been amended in part to incorporate the subject matter of claim 4. The Examiner acknowledges that Cohen does not teach the subject matter of claim 4,

¹ Paragraph numbers refer to the application as published on 25 August 2005 as United States patent application publication no. 2005/0187456.

and in particular does not teach that the second passage may terminate in an opening through a sidewall of the body. Office action, page 3. Applicant therefore submits that Cohen does not anticipate claim 1. Claims 2 and 12 depend from claim 1 and are allowable for at least the same reason. Applicant accordingly respectfully requests reconsideration and withdrawal of the rejection of claims 1, 2 and 12 under 35 U.S.C. § 102(e).

Rejections Under 35 U.S.C. § 103

Claims 4 and 11

The Examiner rejects claims 4 and 11 under 35 U.S.C. § 103 as obvious over Cohen in view of United States patent no. 4,559,951 to Dahl et al. ("Dahl"). To establish a *prima facie* case of obviousness, the Examiner must demonstrate some suggestion or motivation to combine one or more references, with a reasonable expectation of success, to teach or suggest each and every claimed limitation. MPEP § 2142. Applicant contends that the Examiner has failed to meet this burden with respect to the rejected claims as amended herein. Specifically, the asserted combination does not teach or suggest each and every element of the claimed invention.

Claim 4 has been canceled, and its subject matter has been incorporated into claim 1 from which it originally depended. Thus, the rejection of claim 4 will be discussed in the context of amended claim 1.

Claim 1 recites "an elongated flexible body having a central lumen . . . a first passage extending through the body *within said central lumen* . . . [and] a second passage *within said central lumen*" (Emphasis added.) That is, the present invention incorporates a tubular outer body (30) with a hemispherical dome portion (34) sealing its distal end. Specification, paragraph [0022]. As can be seen in Figures 2-5, this construction defines a central lumen. Disposed within the central lumen are two passages—a first passage (62) that delivers an inflation liquid to the annular inflatable member (60) and a second passage (70). Specification, paragraphs [0024]-[0025] and

Figures 2-5. In other words, the tubular outer body does not *define* the first and second passages, but rather *contains* them.

Though Dahl does teach that lumens may terminate through the sidewall of the catheter, Dahl teaches that these additional lumens are created during extrusion of the catheter shaft. Dahl, col. 9, lines 49-52. As best illustrated by Figure 9, Dahl lacks a central lumen defined by shaft 40; rather, shaft 40 defines *three separate, non-central* lumens 42, 44, and 46. Thus, rather than yielding a catheter with first and second passages "within" a central lumen defined by the body, the asserted combination teaches a catheter where all passages are separate from each other, and where none of the passages are contained in others of the passages.

In light of the foregoing, Applicant submits that the asserted combination does not establish a *prima facie* case of obviousness as to claim 1. Claim 11, which depends from claim 1, is allowable for at least the same reasons. Applicant accordingly respectfully requests reconsideration and withdrawal of this rejection.

Claims 5-10, 13-15, and 18

The Examiner rejects claims 5-10, 13-15, and 18 under 35 U.S.C. § 103 as obvious over Cohen in view of United States patent application publication no. 2002/0065514 to Rashidi ("Rashidi"). The rejection of claims 10 and 15 are moot in view of their cancellation. As to the remaining claims, Applicant respectfully disagrees.

Claims 5-9 depend from claim 1. The addition of Rashidi does nothing to overcome the deficiencies of the combination of Cohen and Dahl with respect to claim 1, discussed at length above. Thus, Applicant submits that the rejection of claims 5-9 is improper for at least the reasons discussed above.

Amended claim 13 also contains the recitations of amended claim 1 discussed above. Applicant therefore submits that claim 13, and claims 14 and 18 depending therefrom, are allowable for at least the same reasons.

In light of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 5-9, 13, 14, and 18.

Claims 16 and 17

The Examiner rejects claims 16 and 17 under 35 U.S.C. § 103 as obvious over Cohen in view of Rashidi and Dahl. Claim 16 has been canceled, and its subject matter has been incorporated into claim 13 from which it originally depended. Thus, the rejection of claim 16 will be discussed in the context of amended claim 13.

As discussed above, amended claim 13 also contains the recitations of amended claim 1 discussed above. The addition of Rashidi does nothing to overcome the shortcomings of the combination of Cohen and Dahl, discussed at length above. Thus, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness as to amended claim 13. Claim 17 depends from claim 13 and is allowable for at least the same reasons. Applicant therefore respectfully requests reconsideration and withdrawal of this rejection.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the application is in condition for allowance, and requests that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

No extension is believed necessary for this paper to be considered timely. Should an extension be deemed necessary, Applicant hereby petitions therefor under 37 C.F.R. § 1.136.

Authorization is hereby granted to charge any fees due with the filing of this document, including any fees for any extensions of time deemed necessary, to Deposit Account No. 50-1129 with reference to Attorney Docket No. 82410-0109/0B-045400US.

Respectfully submitted,
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